



UNITED STATES PATENT AND TRADEMARK OFFICE

19 JUN 2008

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

David M. Carter
Carter, DeLuca, Farrell & Schmidt, LLP
Suite 225
445 Broad Hollow Road
Melville NY 11747

In re Application of :
Plant, David James :
Application No.: 10/797,756 :
Filed: March 10, 2004 : DECISION ON PETITION
Attorney Docket No.: 1315-22 :
For: FLEXIBLE ENERGY ABSORBING :
MATERIAL AND METHODS OF :
MANUFACTURE THEREOF :

This is a decision on the petitions under 37 CFR 1.55(c) and 1.78(a)(3), filed June 21, 2007 to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed international applications set forth in the amendment filed concurrently with the instant petition.

Petition under 37 CFR 1.78(a)(3)

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional

information where there is a question whether the delay was unintentional.

The petition does not comply with item (1) above.

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. The amendment submitted with the present petition indicates that “the present application is a continuation application which claims the benefit of and priority to International Application no.

PCT/GB02/04209 filed on September 13, 2002. . .” As the amendment was submitted under the provision of 37 CFR 1.116, entry of the amendment is decided by the examiner. However, even if the amendment was entered, the petition could not be granted. While the amendment identifies the instant application as a continuation application, it does not identify which application it is a continuation of. As such, the reference fails to comply with 37 CFR 1.78(a)(2). An example of a proper benefit claim is: “This application is a continuation of International Application No. PCT/GB02/04209, filed September 13, 2002. . .” See MPEP Section 201.11, Reference to Prior Application.

The petition under 37 CFR 1.78(a)(3) is **DISMISSED**.

Petition under 37 CFR 1.55(c)

The present application, filed after November 29, 2000, did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) The nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;
- (2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6));
- (3) the surcharge as set forth in 37 CFR 1.17(t);
- (4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. (The Commissioner may require additional information where there is a question whether the delay

was unintentional); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

Item (5) has not been satisfied. The above-identified nonprovisional application was filed on March 10, 2004, which is after November 29, 2000, but not within the 12 months of September 13, 2001 or October 4, 2001, the filing date of the foreign application to which benefit is now being claimed. Until the necessary corrections have been made under 37 CFR 1.78, the petition under 37 CFR 1.55 cannot be granted.

Therefore, the Petition under 37 CFR 1.55(c) is **DISMISSED** without prejudice.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PCT
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop PCT
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-0459
ATTN: Office of PCT Legal Administration

Any questions concerning this matter may be directed to Anthony Smith at (571) 272-3298.

This matter is being referred to Technology Center 1717 for any further processing, as deemed necessary in light of this decision.



Boris Milef
PCT Legal Examiner
PCT Legal Administration